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John J. Sie

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06/30/2006

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EXAMINER

BOUTAH, ALINA A

ART UNIT

PAPER NUMBER

2143

DATE MAILED: 06/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/877,317

Applicant(s)

SIE ET AL.

Examiner

Alina N Boutah

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2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This action is in response to Applicant's amendment filed April 12, 2006. Claims 1-21 are pending in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 9 and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 is rejected because the specification fails to disclose: recording at least a second segment of each of a second plurality of programs sent from the content provider if the user request is not detected before a stagger period expires.

Claim 9 is rejected because the specification fails to disclose determining if any of a first segment of each of a plurality of programs sent from the content provider before any before any user request for any of the plurality of programs are not already stored.

Claim 19 is rejected because the specification fails to disclose discontinuing the recording of the first segment if the user request is not detected before the period expires.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,729,280 issued to Inoue et al. (hereinafter referred to as Inoue).

Regarding claim 1, Inoue teaches a method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording at least a first segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs (col. 3, lines 60-63; col. 8, lines 35-46);

detecting the user request for one of the first plurality of programs (col. 5, lines 18-31);

recording at least a second segment of each of a second plurality of programs sent from the content provider if the user request is not detected before a stagger period expires (figures 2A-B); and

recording the one of the first plurality of programs if the user request is detected before the stagger period expires (col. 6, lines 14-24).

Although Inoue does not explicitly mention “stagger period,” it should be noted that the “offset interval” (i.e. “T1” in figure 2) is interpreted as “stagger period.”

Regarding claim 2, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the stagger period is a time duration between beginning the first plurality of programs and the second plurality of programs (figure 2A: “T1”).

Regarding claim 3, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the content provider is a cable television provider (col. 4, line 4).

Regarding claim 4, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the first plurality of programs are multiplexed together in a single datastream (col. 1, lines 46-60).

Regarding claim 5, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein: the first plurality of

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programs is transported with a first transponder, and the second plurality of programs is transported with a second transponder (figure 1: 102).

Regarding claim 6, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, further comprising a step of playing the one of the first plurality of programs (abstract).

Regarding claim 7, although Inoue does not explicitly teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the detecting step comprises steps of: receiving a wireless request from a remote control; and processing the wireless request to determine a desired program, he teaches receiving request from user's controlling device, which in this case could be wired or wireless (col. 2, line 58 to col. 3, line 13).

Regarding claim 8, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 1, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location (col. 8, lines 35-62).

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Regarding claim 9, Inoue teaches a method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

determining if any of a first segment of each of a plurality of programs sent from the content provider before any user request for any of the plurality of programs are not already stored (col. 8, lines 35-62);

recording any first segment of each of the plurality of programs that are not already stored (col. 8, lines 35-62);

detecting the user request for one of the plurality of programs (col. 8, lines 35-62); and

recording a second segment of the one of the plurality of programs in response to the detecting step (col. 8, lines 35-62).

Regarding claim 10, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of recording any remaining segments of the one of the plurality of programs (col. 8, lines 35-62).

Regarding claim 11, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different digital channels (figure 2).

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Regarding claim 12, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first segment and the second segment are on different transponders (figure 1).

Regarding claim 13, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, further comprising a step of playing the one of the plurality of programs (abstract).

Regarding claim 14, although Inoue does not explicitly teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the detecting step comprises steps of: receiving a wireless request from a remote control; and processing the wireless request to determine a desired program, he teaches receiving request from user's controlling device, which in this case could be wired or wireless (col. 2, line 58 to col. 3, line 13).

Regarding claim 15, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 9, wherein the first listed recording step comprises a step of recording the first segment on a mass storage device associated with a set top box that is proximate to the user location (figure 1).

Regarding claim 16, Inoue teaches a method for receiving a program by a user location that is sent from a remote provider, the method comprising steps of:

recording at least a segment of each of a first plurality of programs sent from the content provider before any user request for any of the first plurality of programs (col. 8, lines 35-62);

detecting the user request for one of the first plurality of programs (col. 8, lines 35-62);
and

continuing to record the one of the first plurality of programs beyond a stagger period based upon the detecting step (col. 8, lines 35-62).

Regarding claim 17, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 16, wherein the stagger period is the time between beginning the first plurality of programs and a second plurality of programs (figure 2).

Regarding claim 18, Inoue teaches the method for receiving the program by the user location that is sent from the remote provider as recited in claim 16, wherein the recording step comprises a step of recording the segment on a mass storage device associated with a set top box that is proximate to the user location (col. 4, lines 47-54).

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Regarding claim 19, Inoue teaches a method for receiving a program by a user location that is sent from a content provider, the method comprising steps of:

recording a first segment of the program sent from the content provider before any user request for the program (col. 8, lines 35-62);

detecting the user request for the program (col. 8, lines 35-62);

recording a second segment of the program if the user request is detected before the period expires (col. 8, lines 35-62); and

discontinuing the recording of the first segment if the user request is not detected before a period expires, wherein the period is less than a duration of the program (col. 8, lines 35-62).

Regarding claim 20, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the detecting step comprises a step of detecting the user request for the program during the step of recording the first segment (col. 8, lines 35-62).

Regarding claim 21, Inoue teaches the method for receiving the program by the user location that is sent from the content provider as recited in claim 19, wherein the recording steps comprise a step of recording on a rotating disk at the user location (col. 4, lines 36-46).

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Response to Arguments

The examiner is unable to find the support for the argued elements in the claims (see the 112 rejection above). Applicant is hereby requested to specifically point out where each of these limitations is taught. Until then, the arguments will not be given patentable weight.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N. Boutah whose telephone number is 571-272-3908. The examiner can normally be reached on Monday-Friday (9:00 am - 5:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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